

Application No.: 10/518324
 Docket No.: BA9308USPCT

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REMARKS

I.

In the Office Action, the lack of unity requirement was deemed proper and made final. The Office Action maintained *inter alia* that the special technical feature of Group I is a benzo[1,3]oxazinone ring and is different from the special technical feature of Group II, and that the special technical feature of Group III involves ring-opening reaction of a benzo[1,3]oxazinone ring that is not present in Group I.

Applicant respectfully points out that despite the "differences" noted in the Office Action, all of the original claims still are linked by a single general inventive concept: the process sequence represented by (1), (2) and (3) in original Claim 1 that can be used in connection with the preparation of fused oxazinones as recited in that claim (a sequence involving *inter alia* certain common structures and mole ratio aspects as described in the Response dated February 8, 2007). Nevertheless, in order to expedite prosecution of this application, Claim 1 has been canceled and new independent claims 12 and 15 have been added. Claim 12, which largely corresponds to original Claim 6 recites *inter alia* that K is, together with the two contiguous linking carbon atoms, a fused phenyl ring optionally substituted with from one to four substituents independently selected from G, U, W or R¹³ (as defined in that claim) and Claim 15, which largely corresponds to original Claim 8, includes the fused phenyl ring in the structure if Formula 1a. Claim 10 has been amended so that *inter alia* it depends from Claim 12, and Applicant submits that even assuming *arguendo* that it was properly subject to a unity of invention objection, it can nevertheless be considered for rejoinder upon allowance of the claim from which it depends.

Applicant notes that the Office Action also indicated that Applicant has to limit the definition of J (Claim 8 was referenced). In the 35 USC 112 Claim Rejections section of the Office Action the phrase "J is an optionally substituted carbon moiety" was objected to as indefinite, and it was recommended that Applicant limit J to pyrrole derivative. However, in the original restriction Claim 7 was included in the Group I claims and there was no discussion of J as a special technical feature distinguishing Group I from the other claim groups. Moreover, although election of a single disclosed species was required in the event Applicant elected Group II, all Js were apparently included within Group II.

II.

The Office Action indicated that application No. 10/518325 as listed in the Information Disclosure Statement for this application was not considered because it is not a patent. Inasmuch as pending applications can be pertinent to patentability, Applicant respectfully requests consideration of that document as a pending application. As noted in the Information Disclosure Statement, that application is a national filing of WO 04/011453.

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Moreover, Applicant notes that Application No. 10/518325 published on September 29, 2005 as 2005/0215798.

III.

In the Office Action Claims 1 through 9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action *inter alia* objected to the phrase "carboxylic acid" in Claim 1, the phrase "J is an optionally substituted carbon moiety" in Claim 2 and the phrase "including" in Claim 5 as indefinite.

Applicant submits that "carboxylic acid" and "optionally substituted carbon moiety" are sufficiently definite, particularly when read in light of the specification. Nevertheless, Applicant notes that carboxylic acids and J are now more explicitly defined in independent Claim 12, and carboxylic acids are now more explicitly defined in independent Claim 15 (J is not used in Claim 15). Applicant submits that the term "including" as used in original Claim 5 is not indefinite, and notes that it is used to refer to certain groups that might optionally be included as ring members. This terminology is further illustrated in the application itself (see e.g., page 12, line 4 to page 14, line 10). Applicant notes that the term "optionally including" is used in the Claim 12 definitions of J and G.

The Office Action appeared to object in general to the term "substituted" in all occurrences wherein particular moieties are not sufficiently identified in the claim.

Applicant submits that "substituted" as used in the original claims was sufficiently definite, particularly when read in light of the specification. In any event, Applicant notes that the use of the term "optionally substituted" in the phrase "optionally substituted pyridine compound" in original Claim 1 appears to have been superfluous (see e.g., page 6, lines 2 to 3) and that term has been omitted in new independent claims 12 and 15.

IV.

As noted above, new Claim 12 corresponds largely with original Claim 6. The differences between new Claim 12 and original Claim 6 include the limitation of K in new Claim 12 as indicated above, the omission of the term "optionally substituted" in new Claim 12 in connection with the pyridine compound as indicated above, and omission of groups containing "L" from the definition of R¹² (i.e., R¹⁹C(=E)L-, R¹⁹LC(=E)-, (R¹⁹)LC(=E)L-, -SO₂LR¹⁸ and R¹⁹SO₂L-). Claims 3, 7, 8 and 10 have been amended to depend from new Claim 12. R⁹ in claims 8 and 10 have been amended consistent with that new dependency, and Claim 4 (which depends from Claim 3) has been amended to delete the term "optionally substituted" (consistent with new Claim 12). The wording of Claim 10 has also been somewhat changed. Claims 13 and 14 have been added to recite certain pyridine compounds

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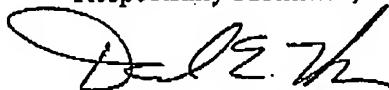
and certain sulfonyl chloride compounds, respectively (see, e.g., page 8, lines 24 to 35 and page 20, lines 28 to 29, respectively).

As noted above, new Claim 15 corresponds largely with original Claim 8. The differences between new Claim 15 and original Claim 8 include the omission of the term "optionally substituted" in new Claim 15 in connection with the pyridine compound as indicated above. Claims 16 through 21 have been added to depend directly or indirectly from new Claim 15. Applicant notes amended claims 13, 14, 3, 4 10 and 11 in connection with new claims 16 through 21 respectively; and further notes in particular the different wording of new Claim 20 as compared to the wording in amended Claim 10.

Claims 1, 2, 5 and 6 have been canceled.

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



DAVID E. HEISER
ATTORNEY FOR APPLICANT
Registration No.: 31,366
Telephone: (302) 892-1926.
Facsimile: (302) 892-7949

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